



Patent
247/062

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Ross S. Tsugita and Tracy D. Maahs

Serial No.: 09/467,293

Filed: December 17, 1999

For: BALLOON OCCLUSION DEVICE
AND METHODS OF USE

Group Art Unit: 3763

Examiner: M. Mendez

[Handwritten signatures and initials]

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RESPONSE UNDER 37 CFR § 1.111

Commissioner for Patents
Washington, D.C. 20231

Sir:

Reconsideration of the rejections set forth in the Office Action dated April 25, 2000 is respectfully requested. Claims 1-27 were rejected under 35 USC § 103 as allegedly unpatentable over Gabbay in view of Miller and Buckberg. Independent claim 1 is limited to an assembly that includes both a filter and an expandable occluder deployable from the distal region of a cannula. Independent claim 19 recites a method and is limited to steps of deploying a filter and expanding an occluder. None of the references to Gabbay, Miller or Buckberg teach or suggest the use of a separately insertable filter through a cannula in combination with an expandable occluder deployable from the distal region of the cannula. In fact, Miller describes a filter for use in the vena cava during

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CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

August 25, 2000
Date of Deposit

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Patent
247/062

joint replacement surgery to prevent pulmonary arterial blockage. There is no teaching or suggestion that balloon occlusion would be desirable in the vena cava in combination with a filter to prevent pulmonary embolism. With regard to Gabbay, there is no indication that the use of a filter in the aorta would be desirable in combination with the occluder and intraoperative balloon pump. Thus, there would have been no incentive for a person skilled in the art to have made the combination of Gabbay and Miller, as asserted by the Examiner.

Moreover, Applicants note that a claim substantially similar to the claims pending herein were presented for examination in a related parent application, Barbut et al., U.S. application serial no. 08/645,762, filed May 14, 1996. The '762 application was assigned to the same examiner as the present application, and the claims of the '762 application were allowed in an office action dated August 26, 1997. Applicants therefore respectfully assert that the claims pending in the present application are allowable for the same reasons that the claims presented in the '762 application were determined to be allowable.

For all of the foregoing reasons, the rejections under 35 USC § 103 should be withdrawn.

Please note that an Information Disclosure Statement was filed March 14, 2000 in the present application. Applicants did not receive a copy of the Form PTO-1449 submitted with that Information Disclosure Statement. It is therefore again requested that the Examiner fully consider the art cited in that Form PTO-1449, initial the leftmost column of each form adjacent each cited reference, and return a copy for Applicants' records. It is further requested that the art be cited on the cover of any patent issuing from the subject application.



Patent
247/062

Favorable action on the merits of the claims is therefore earnestly solicited. If any minor issues remain, please contact John Kappos, Attorney of Record, at 949-567-2300.

A petition for a one-month extension of time to file a response is submitted herewith and included is payment of the fee. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 12-2475 or to credit such account if overpayment has been made.

Respectfully submitted,

LYON & LYON LLP

Dated: August 25, 2000

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